

REMARKS

Applicant respectfully requests reconsideration of the present application. No new matter has been added to the present application. Claims 1-10 and 12-30 have been rejected in the Office Action. Claims 1 and 25 have been amended, and new claim 31 has been added in the Amendment. Accordingly, claims 1-10 and 12-31 are pending herein. Claims 1-10 and 12-31 are believed to be in condition for allowance and such favorable action is respectfully requested.

Applicants' representative thanks the Examiner for granting a telephonic interview on February 5, 2007. During the interview, differences between the independent claims and applied art, U.S. Patent No. 5,913,040 to Rakavy et al. (the "Rakavy reference") and U.S. Patent No. 6,327,677 to Garg et al. (the "Garg reference"), were discussed. Applicants' representative indicated that the Rakavy and Garg references, either alone or in combination, fail to teach or suggest all of the claim limitations of the independent claims. For instance, Applicants' representative explained that the Rakavy and Garg references fail to teach or suggest identifying a maximum monitored level of actual bandwidth utilization and calculating a threshold level of utilization as a function of the maximum monitored level of utilization as recited in independent claim 1. Additionally, Applicants' representative noted that there is no suggestion or motivation to combine or otherwise modify the references to achieved the claimed invention.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.04. In order "[t]o establish a *prima facie* case of obviousness,

three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)". See MPEP § 2143. Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat. App. & Inter. 1985)." *Id.* See also MPEP § 706.02(j) and § 2142.

B. Rejections based on Rakavy and Chiu

Claims 1-9, 14-27, and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Rakavy reference in view of the Garg reference. Applicants respectfully traverse the obviousness rejection for claims 1-9, 14-27, and 29-30. In particular, the Rakavy and Garg references, either alone or in combination, fail to teach or suggest all the claim limitations for each of these claims. Additionally, there is no suggestion or motivation to combine the Rakavy and Garg references in the manner set forth in the Office Action dated 12/6/2006, nor is there any suggestion or motivation to modify the Rakavy and/or Garg references to achieve the claimed invention.

1) Claims 1-9, 14-21, 29, and 30

Independent claim 1 is directed to a method of transferring a set of data over a network between a local computing device and a remote computing device. In accordance with the method of claim 1, the level of actual network bandwidth utilization of the local computing device is monitored. *Id.* at p. 14, lines 15-20. A maximum of the monitored level of actual network bandwidth utilization of the local computing device is identified. *Id.* at p. 16, lines 8-12. A threshold level of utilization is then calculated as a function of the maximum monitored level of actual network bandwidth utilization. *Id.* at p. 16, lines 12-17. If the actual level of network bandwidth utilization is less than the threshold level, at least a portion of the set of data is transferred over the network between the local computing device and the remote computing device. *Id.* at p. 17, lines 4-14.

The Rakavy reference discusses a type of software technology that is referred to as a “Polite Agent.” *Rakavy*, col. 13, lines 5-6. The Polite Agent “transmits information during periods of low line utilization.” *Id.* at col. 13, lines 11-12. “Low line utilization occurs when the communications line is busy no more than a predetermined percentage of the time.” *Id.* at col. 13, lines 35-36. At a point when “the communications resource utilization remains low and ample resources are available the software agent performs its designated data transfer task.” *Id.* at col. 13, lines 23-25.

Although Rakavy’s method and the invention of claim 1 address essentially the same problem, there are significant differences between the two approaches with respect to how a threshold below which data may be transferred is established. In particular, the “Polite Agent” software technology discussed in the Rakavy reference uses a predetermined percentage of time that a communications line is busy as a threshold (*see, e.g., Rakavy*, col. 13, lines 35-44), while the invention in claim 1 uses a threshold level calculated based on a maximum monitored level

of actual network bandwidth utilization. The Rakavy reference fails to teach or suggest “identifying a maximum monitored level, wherein the maximum monitored level is a maximum of the monitored level of actual network bandwidth utilization” and “calculating a threshold level of utilization as a function of the maximum monitored level of utilization.” Following from its failure to teach or suggest calculating a threshold level based on a maximum monitored level of actual network bandwidth utilization, the Rakavy reference necessarily also fails to teach or suggest the last element: “if the actual level is less than the threshold level, receiving at least a portion of the set of data over the network.”

The differences between the approach in the Rakavy reference and the invention of claim 1 are significant. Instead of relying on the percentage of time that a communications line is busy as in the Rakavy reference, the method of claim 1 includes identifying a maximum monitored level of actual network bandwidth utilization and using that maximum monitored level to calculate a threshold level below which data may be received. As such, the invention of claim 1 provides a substantial advantage over the Rakavy reference’s solution in that the invention of claim 1 optimizes the use of network bandwidth. By contrast, the Rakavy reference’s solution is less effective because downloading data based on the percentage of time the network connection is busy will often result in underutilization of the network bandwidth (as explained in Applicants’ specification at page 16, line 18 through page 17, line 1).

The Examiner has acknowledged that the Rakavy reference fails to disclose multiple limitations of the invention of claim 1 (*see, e.g., Office Action dated 12/06/2006, p. 3*), but has minimized the extent of the differences between the Rakavy reference and claim 1. As set forth by the United States Supreme Court in *Graham v. John Deere*, 383 U.S. 1 (1966), inquiries as a background for determining obviousness include, *inter alia*, determining the scope

and contents of the prior art, and ascertaining the differences between the prior art and the claims at issue. *See, e.g.*, MPEP § 2141. In the present case, the Examiner has not adequately ascertained the differences between the Rakavy reference and the invention of claim 1. The approach in Rakavy does not involve identifying a maximum monitored level of actual bandwidth utilization, using that maximum monitored level to calculate a threshold level, and transferring data when the actual bandwidth utilization is less than that calculated threshold level. Rather, the Rakavy reference teaches a different approach based on the percentage of time the network connection is busy. Rakavy's approach is a less effective one for the reasons stated above and in Applicants' specification at page 16, line 18 through page 17, line 1. Thus, the Applicants' claimed invention advances the state of the art beyond what is taught in the Rakavy reference.

The Garg reference was cited by the Examiner in an attempt to demonstrate that the differences between the invention of claim 1 and the Rakavy reference were merely obvious differences. However, the Examiner's conclusion is based on not only an incorrect understanding of claim 1 as noted above, but also an incorrect understanding of what is taught in the Garg reference.

The Garg reference relates to a system for monitoring a network environment to determine whether a problem or potential problem exists in the network. *See, e.g., Garg*, Abstract; col. 2, lines 38-42. The system monitors the network environment by collecting recent operating data associated with the network environment. *Id.*, at Abstract; col. 2, lines 53-55. The network environment is analyzed by comparing the collected data against cognitive signatures to identify problems in the network environment. *Id.*, at Abstract; col. 2, lines 55-61. A cognitive signature represents a normal operating mode based on historical data, and separate

cognitive signatures are maintained for different time periods for different days of the week. *Id.*, at col. 5, lines 32-33; col. 8, lines 26-28. For instance, a cognitive signature may represent the normal operation for Monday from 9:00 am – 10:00 am. *Id.*, at col. 8, lines 59-61. By comparing collected data against a cognitive signature for a given time period, the system in the Garg reference can determine whether the collected data deviates from normal operation represented by the cognitive signature. *See, e.g., id.*, Abstract, col. 2, lines 39-61; col. 5, lines 32-33; col. 8, lines 26-28.

The Garg reference simply does not teach or suggest any steps related to “identifying a maximum monitored level, wherein the maximum monitored level is a maximum of the monitored level of actual bandwidth utilization of the local computing device” and “calculating a threshold level of utilization [below which data may be transferred as indicated by the last element of claim 1] as a function of the maximum monitored level of utilization” as recited by claim 1. The Examiner appears to be either misinterpreting the Garg reference or taking what the Applicants have taught in the present application and attempting to read these limitations into the Garg reference. As noted hereinabove, claim 1 is concerned with transferring data in a manner that minimizes interference with other data transmissions, and, as the threshold for the data transfer is based on the maximum monitored level of utilization, the data transfer can take advantage of otherwise unused bandwidth with minimal impact on other network traffic. In contrast, the Garg reference is not concerned with transmitting data in the background of other data transmissions. Instead, the Garg reference is concerned with monitoring a network environment for problems by analyzing collected data to determine if it deviates from normal operations (as indicated by historical network data defined by cognitive signatures). Examining

a network environment to determine if recent data deviates from normal operations is significantly different from the recited limitations of independent claim 1.

Additionally, the invention of claim 1 employs a threshold level of utilization at which interference with other network activity caused by a background data transmission will be minimized. In particular, claim 1 sets the threshold level of utilization below an identified maximum monitored level of utilization to ensure that there is sufficient bandwidth to allow background data transmission while minimizing interference with other data transmissions. In contrast, the cognitive signatures discussed in the Garg reference represent historical operating information for a given time period (e.g., Monday 9:00 am – 10:00 am). By using cognitive signatures, the Garg reference can determine whether current network operation deviates from historical network operation for the time period corresponding with the current network operation. For instance, the system in the Garg reference may monitor the network on a particular Monday between 9:00 am and 10:00 am and compare the collected data against historical information for that time period (i.e., Monday 9:00 am – 10:00 am) to determine whether there is a problem. Clearly, this is different from the invention of claim 1 in which a threshold value is determined based on a maximum monitored level of utilization for a local computing device and used to determine whether a background data transmission may occur with minimal interference with other data transmissions.

Moreover, there is no suggestion or motivation to combine the Rakavy and Garg references, nor is there any suggestion or motivation to modify the Rakavy and/or Garg references to achieve the invention of claim 1. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.

1991).” See MPEP §§ 706.02(j), 2142, and 2143. Factual findings in support of a *prima facie* case of obviousness must be supported by substantial evidence. *In re Zurko*, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001).

“The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusions that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat App. & Inter. 1985).” MPEP § 2142.

MPEP § 2142 further states that “[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper.” The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” *Dembiczak*, 50 USPQ2d at 1617. ““The factual inquiry whether to combine the references must be thorough and searching.”” *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. *Id.* at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. *In re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Examiner has not presented any evidence why the Rakavy and Garg references would have been combined or otherwise modified to achieve the invention of claim 1. The Examiner's sole rationale for making such a combination is that the disclosure of Rakavy "would motivate one of ordinary skill in the art to search for other methods of bandwidth utilization determining [sic], eventually finding the system of Garg, which compares recent network utilization with historical network operation." Office Action dated 12/06/2006, p. 4. This statement illustrates not only a lack of understanding as a matter of fact with respect to the teachings of the Rakavy and Garg references but also demonstrates an error as a matter of law. The proper determination for a *prima facie* case of obviousness is whether there is any suggestion or motivation to modify the references or to combine reference teachings, not whether there is any motivation to search for other teachings. Moreover, the Examiner's statement regarding motivation to search implies that the Examiner has used impermissible hindsight in an attempt to find the claimed invention obvious.

The Examiner has failed to provide any suggestion or motivation, nor is there any suggestion or motivation, to combine the Rakavy and Garg references. Such suggestion or motivation does not appear anywhere in either of the references, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references. The Garg reference is outside the art relating to controlling a data transfer. As such, there is no motivation to combine the Garg reference because the Garg reference is intended for a different type of problem in a different area of art. The Rakavy reference is concerned with limiting a download to periods of low line utilization (based on percentage of time that a communications line is busy), while the Garg reference is

concerned with monitoring the performance of a network to identify problems. The Examiner has not identified any problems with the technique of the system in the Rakavy reference itself, nor does the Rakavy reference itself suggest any shortcoming with how it finds a threshold. In sum, no teaching of the Rakavy or Garg references or elsewhere suggests that the system in the Garg reference would improve a system such as in the Rakavy reference, and nothing in the references or elsewhere suggest a need for any particular improvement to the system in Rakavy.

Accordingly, Applicants respectfully submit that independent claim 1 is patentable over the Rakavy and Garg references for at least the reasons described hereinabove. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 1. Each of claims 2-9, 14-21, 29, and 30 depends, either directly or indirectly, from independent claim 1, and accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons.

2) Claims 22-24

Referring now to claims 22-24, as noted above, independent claim 22 is directed to a computer-readable medium have stored thereon a data structure. *Id.* at p. 6, line 16 through p. 8, line 9; p. 13, lines 19-23. The data structure includes a first data field containing data representing a maximum monitored level, wherein the maximum monitored level is a maximum of a monitored level of actual network bandwidth utilization. *Id.* at p. 12, lines 10-14; p. 13, line 19 through p. 14, line 2; p. 16, lines 8-12. Additionally, the data structure includes a second data field containing data representing a threshold level of network bandwidth utilization below which data may be transferred over the network without interfering with other network activity, wherein the second data field is derived from the first data field by calculating the threshold level as a function of the maximum monitored level. *Id.* at p. 12, lines 10-14; p. 13, line 19 through p. 14, line 2; p. 16, lines 12-16.

On page 9 of the Office Action dated 12/06/2006, the Examiner rejected claims 22-24 for “similar reasons as stated above,” presumably referring to the rejection of claims 1, 3, and 5 and the combination of the Rakavy and Garg references. Applicants respectfully traverse the obviousness rejection of claims 22-24 because the Rakavy and Garg references, either alone or in combination, fail to teach or suggest all the claims limitations for each of these claims. In particular, the references fail to teach or suggest a computer-readable medium having a data structure as that recited in independent claim 22. First, the Rakavy and Garg references, either alone or in combination, fail to teach or suggest a data structure that includes “a first data field containing data representing a maximum monitored level, wherein the maximum monitored level is a maximum of a monitored level of actual network bandwidth utilization” as recited by independent claim 22. As noted above with respect to independent claim 1, the Rakavy reference fails to teach anything remotely similar to a maximum monitored level of actual network bandwidth utilization. The Garg reference fails to cure this deficiency as the reference is concerned with monitoring a network based on cognitive signatures to identify network problems, which differs from a maximum monitored level of actual network bandwidth utilization as recited by independent claim 22.

Next, the Rakavy and Garg references, either alone or in combination, fail to teach or suggest a data structure that includes “a second data field containing data representing a threshold level of network bandwidth utilization below which data may be transferred over the network without interfering with other network activity, wherein the second data field is derived from the first data field by calculating the threshold level as a function of the maximum monitored level” as recited by independent claim 22. The threshold used in the Rakavy reference is based on a predetermined percentage of time a communications line is busy as

opposed to being calculated as a function of a maximum monitored level. This difference is significant as noted hereinabove and in Applicants' specification at page 16, line 18 through page 17, line 1. The Garg reference also fails to cure the deficiency of the Rakavy reference with respect to this limitation. As previously noted, the Garg reference is concerned with monitoring a network using cognitive signatures to identify problems. The Garg reference simply fails to teach or suggest any threshold level of network bandwidth utilization below which data may be transferred without interfering with other network activity. In contrast, the Garg reference specifically discusses identifying problems by determining whether current data deviates from historical data for a time period corresponding with the current data.

Moreover, there is no suggestion or motivation to combine the Rakavy and Garg references to achieve the invention of claims 22-24 and the combination is improper for at least the same reasons as noted above with respect to independent claim 1.

Accordingly, Applicants respectfully submit that independent claim 22 is patentable over the Rakavy and Garg references for at least the reasons described hereinabove. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 22. Each of claims 23 and 24 depends from independent claim 22, and accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons.

3) Claims 25-27

Turning now to claims 25-27, independent claim 25 is directed to a computer-readable medium having computer-executable components for managing the transfer of data over a network. The components include a bandwidth monitoring component, a threshold calculating component, and a transfer management component. The bandwidth monitoring component monitors the level of actual bandwidth utilization for a network connection and

identifies a maximum monitored level, wherein the maximum monitored level is a maximum of the monitored level of actual bandwidth utilization for the network connection. *Id.* at p. 14, lines 15-20; p. 16, lines 8-12. The threshold calculating component calculates a threshold level of utilization as a function of the maximum monitored level of utilization identified by the bandwidth monitoring component. *Id.* at p. 16, lines 12-17. The transfer management component manages the transfer of data over the network when the level of actual bandwidth utilization is less than the threshold level of utilization. *Id.* at p. 17, lines 4-14.

On page 9 of the Office Action dated 12/06/2006, the Examiner rejected claims 25-27 for “similar reasons as stated above,” presumably referring to the rejection of claims 1, 3, and 5 and the combination of the Rakavy and Garg references. Applicants the obviousness rejection of claims 25-27 because the Rakavy and Garg references, either alone or in combination, fail to teach or suggest all the claims limitations for each of these claims.

Initially, the Rakavy and Garg references, either alone or in combination, fail to teach or suggest a “bandwidth monitoring component which monitors the level of actual bandwidth utilization for a network connection and identifies a maximum monitored level, wherein the maximum monitored level is a maximum of the monitored level of actual bandwidth utilization for the network connection” as recited by independent claim 25. As noted above with respect to independent claim 1, the Rakavy reference fails to teach anything remotely similar to identifying a maximum monitored level of actual network bandwidth utilization. The Garg reference fails to cure this deficiency as the reference is concerned with monitoring a network for problems using cognitive signatures.

Next, the Rakavy and Garg references, either alone or in combination, fail to teach or suggest a “threshold calculating component which calculates a threshold level of

utilization as a function of the maximum monitored level of utilization identified by the bandwidth monitoring component” as recited by independent claim 25. As noted above with respect to independent claim 1, the threshold used in the Rakavy reference is based on a predetermined percentage of time a communications line is busy as opposed to being calculated as a function of a maximum monitored level. This difference is significant as noted hereinabove and in Applicants’ specification at page 16, line 18 through page 17, line 1. The Garg reference also fails to cure the deficiency of the Rakavy reference with respect to this limitation. As previously noted, the Garg reference is concerned with monitoring a network using cognitive signatures to identify problems. The Garg reference simply fails to teach or suggest any threshold level of utilization that is calculated based on a maximum monitored level of actual network bandwidth utilization.

Further, the Rakavy and Garg references, either alone or in combination, fail to teach or suggest “a transfer management component which manages the transfer of data over the network when the level of actual bandwidth utilization is less than the threshold level of utilization” as recited by independent claim 25. Because the Rakavy and Garg references fail to teach or suggest a bandwidth monitoring component and threshold calculating component that provide a threshold level based on a maximum monitored level of utilization, the references similarly fail to teach or suggest a transfer management component that employs such a threshold level to manage the transfer of data.

Moreover, there is no suggestion or motivation to combine the Rakavy and Garg references to achieve the invention of claims 25-27 and the combination is improper for at least the same reasons as noted above with respect to independent claim 1.

Accordingly, Applicants respectfully submit that independent claim 25 is patentable over the Rakavy and Garg references for at least the reasons described hereinabove. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 25. Each of claims 26 and 27 depends from independent claim 25, and accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons.

C. Rejection based on Rakavy, Garg, and Watanabe

Claim 10 was rejected under 35 U.S.C. § 103(a) as being obvious over the Rakavy reference in view of the Garg reference and further in view of the Watanabe reference. Applicants traverse the obviousness rejection of claim 10 because the Rakavy, Garg, and Watanabe references, either alone or in combination, fail to teach or suggest all the claims limitations for claim 10. Dependent claim 10 depends indirectly from independent claim 1, which includes limitations not taught or suggested by the Rakavy and Garg references as described hereinabove. The addition of the Watanabe reference does not cure these deficiencies as the Watanabe reference similarly fails to teach or suggest these limitations. Further, there is no suggestion or motivation to combine the Rakavy, Garg, and Watanabe references in the manner set forth in the Office Action dated 12/06/2006, nor is there any suggestion or motivation to modify the Rakavy, Garg, and/or Watanabe references to achieve the invention of claim 10. Accordingly, the 103(a) rejection of claim 10 is improper for at least the reasons stated above, and Applicants respectfully request that the withdrawal of the 103(a) rejection of claim 10.

D. Rejection based on Rakavy, Garg, and Elzur

Claim 12 was rejected under 35 U.S.C. § 103(a) as being obvious over the Rakavy reference in view of the Garg reference and further in view of the Elzur reference. Applicants traverse the obviousness rejection of claim 12 because the Rakavy, Garg, and Elzur

references, either alone or in combination, fail to teach or suggest all the claims limitations for claim 12. Dependent claim 12 depends indirectly from independent claim 1, which includes limitations not taught or suggested by the Rakavy and Garg references as described hereinabove. The addition of the Elzur reference does not cure these deficiencies as the Elzur reference similarly fails to teach or suggest these limitations. Further, there is no suggestion or motivation to combine the Rakavy, Garg, and Elzur references in the manner set forth in the Office Action dated 12/06/2006, nor is there any suggestion or motivation to modify the Rakavy, Garg, and/or Elzur references to achieve the invention of claim 12. Accordingly, the 103(a) rejection of claim 12 is improper for at least the reasons stated above, and Applicants respectfully request that the withdrawal of the 103(a) rejection of claim 12.

E. Rejection based on Rakavy, Garg, and Kalkunte

Claim 13 was rejected under 35 U.S.C. § 103(a) as being obvious over the Rakavy reference in view of the Garg reference and further in view of the Kalkunte reference. A *prima facie* case of obviousness has not been established for claim 13 because the Rakavy, Garg, and Kalkunte references, either alone or in combination, fail to teach or suggest all the claims limitations for claim 13. Dependent claim 13 depends indirectly from independent claim 1, which includes limitations not taught or suggested by the Rakavy and Garg references as described hereinabove. The addition of the Kalkunte reference does not cure these deficiencies as the Kalkunte reference similarly fails to teach or suggest these limitations. Further, there is no suggestion or motivation to combine the Rakavy, Garg, and Watanabe references in the manner set forth in the Office Action dated 12/06/2006, nor is there any suggestion or motivation to modify the Rakavy, Garg, and/or Watanabe references to achieve the invention of claim 13.

Accordingly, the 103(a) rejection of claim 13 is improper for at least the reasons stated above, and Applicants respectfully request that the withdrawal of the 103(a) rejection of claim 13.

F. Rejection based on Buch, Rakavy, and Garg

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,463,468 to Buch (the “Buch reference”) in view of the Rakavy and Garg references. The Buch reference discloses a technique for free Internet access which involves a method for downloading video advertising files when a user is not actively using the Internet connection. As shown in FIG. 11 and described at column 12, Buch’s method determines the ad block size based on the available data rate and perhaps also based on system resources. If the Internet connection is being used (e.g., to download content or to send/receive email), the method checks the availability of the connection again later. However, if the Internet connection is not being used, a request is sent to the ad server for information such as the file name, the offset from the file start where the block should be downloaded, and the determined ad block size.

The method in the Buch reference differs from that of Applicants’ invention of claim 28 in that Buch’s method does not request and download data in the background during other network activity. The method in the Buch reference does not request and download data provided that the actual network bandwidth utilization is less than a threshold level that is calculated as a function of a maximum monitored level of actual network bandwidth utilization. Instead, the method in the Buch reference only requests and downloads data when the user is not actively using the Internet connection. These are substantial differences because the downloading of data using the invention of claim 28 is not limited to times when the user’s Internet connection is not being actively used as discussed in the Buch reference. This is a significant difference as the invention of claim 28 provides a benefit over the method in the Buch

reference in that data may be downloaded while other network activity occurs. The Examiner acknowledges that the Buch reference fails to teach or suggest multiple limitations of independent claim 28 (see, e.g., *Office Action dated 08/19/2005*, p. 11), but minimizes the extent of the differences between the invention of claim 28 and the Buch reference as noted above.

The Rakavy and Garg references were relied on by the Examiner in an attempt to demonstrate that the differences between the invention recited by claim 28 and the Buch reference are merely obvious differences. However, the Examiner's conclusion is based on not only an incorrect understanding of Applicants' invention of claim 28 with respect to the Buch reference as noted above, but an incorrect understanding of what is taught by the Rakavy and Garg references. As noted above with respect to the obviousness rejection of claims 1-9, 14-27, and 29-30, the Rakavy and Garg references, either alone or in combination, fail to teach or suggest using a threshold level of utilization that is calculated based on an identified maximum monitored level of actual bandwidth utilization. Accordingly, the Buch, Rakavy, and Garg references, either alone or in combination, fail to teach or suggest the method of claim 28. Moreover, there is no suggestion or motivation to combine the Buch, Rakavy, and Garg references in the manner set forth in the Office Action dated 12/06/2006, nor is there any suggestion or motivation to modify the Buch, Rakavy, and/or Garg references to achieve the invention recited by claim 28. Accordingly, Applicants traverse and request withdrawal of the 103(a) rejection of independent claim 28.

New Claim

New independent claim 31 has been added in the listing of claims. Applicants respectfully submit that the cited references fail to teach or suggest the limitations of new

independent claim 31. Accordingly, independent claim 31 is believed to be in condition for allowance and such favorable action is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 1-10 and 12-31 are in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-10 and 12-31. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any underpayment amount required, or refund any overpayment amount, to Deposit Account No. 19-2112.

Respectfully submitted,

/John S. Golian/

John S. Golian
Reg. No. 54,702

SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550